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Paper No. 9

Silverbrook Research PTY LTD
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Technology Center 2100

In re Application of: Silverbrook, et al.)
Application No.: 09/575,165)
Filed: May 23, 2000) **DECISION ON PETITION TO**
Attorney Docket No.: NPA009US) **ACCEPT CORRESPONDENCE AS**
For: METHOD AND SYSTEM FOR) **TIMELY FILED UNDER 37 CFR §1.8**
DELIVERY OF A SECURE DOCUMENT)
)

This is a decision on the petition filed August 2, 2004 to withdraw the holding of abandonment. The petition is being considered under 37 CFR § 1.8(b) as requesting the acceptance of correspondence as timely filed.

The petition is **DISMISSED**.

BACKGROUND

November 17, 2003 Non-Final rejection mailed (Paper No. 6)

June 21, 2004 Notice of Abandonment (Paper No. 7)

August 02, 2004 Instant Petition received (Paper No. 8)

ISSUES

The practitioner has submitted a copy of the original Response to the Non-Final Office action, a Fee transmittal letter, certificate of facsimile transmission dated February 10, 2004 *signed by both Ms. Kia Silverbrook and Paul Lapstun*, a transmission status report showing a status of "OK" for transmission of 17 pages on February 10, 2004, a "statutory declaration" by *Leonie Frances News*, and email communications between Examiner Jacob Lipman and Mr. Pascale Hair (June 9 – June 15, 2004). Mr. Hair states no Auto-Reply acknowledgement was received from the USPTO.

DECISION

In considering petitioners' submission under 37 CFR § 1.8(b), the correspondence can be considered timely filed if petitioners meet at least three conditions:

1. Informs the Office of the previous mailing or transmission of the correspondence promptly after becoming aware that the Office has no evidence of receipt of the correspondence;
2. Supplies an additional copy of the previously mailed or transmitted correspondence and certificate; and
3. **Includes a statement that attests on a personal knowledge basis or to the satisfaction of the Commissioner to the previous timely mailing or transmission.** If the correspondence was sent by facsimile transmission, a copy of the sending unit's report confirming transmission may be used to support this statement.
[Emphasis added.]

The evidence provided by Petitioner supports prompt notification on applicant's part after becoming aware of the previous transmission of the response and a copy of the transmitted correspondence has been included (items 1 and 2 above). However, a question remains as to who submitted the response via facsimile since the statutory declaration merely indicates that "The facsimile was sent". Therefore, Petitioner needs to submit a personal knowledge statement (in compliance) *by the individual sending the original transmission* [emphasis added]. While the third condition of 37 CFR § 1.8(b) permits submission of the sending unit's transmission report to support such a statement, *it is not intended to be a substitute for such a statement*. Any statement from Mr. Leonie Frances News (or Kia Silverbrook and Paul Lapstun) should focus on his or her *personal knowledge* regarding the timeliness of the transmission itself.

It is noted in the petition, the certificate of transmission/ mailing does not reflect the facsimile number to which the Office actions response was sent. This fact will not prohibit a future grant of this petition, but it is suggested Practitioner can avoid future problems relating to use of the facsimile for official submissions by modifying in-house procedures and following up transmissions with a query to the Office if an "Auto-Reply" is not received.

In addition, Applicant is reminded of the proper use and procedures regarding Internet communications via email, as set forth in M.P.E.P. 502.03, which states in part,

>I. < CONFIDENTIALITY OF PROPRIETARY INFORMATION (ARTICLE 4)

If security and confidentiality cannot be attained for a specific use, transaction, or activity, then that specific use, transaction, or activity shall NOT be undertaken/conducted.

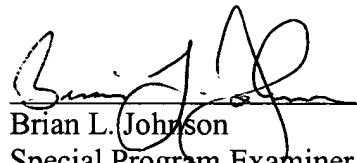
All use of the Internet by Patent Organization employees, contractors, and consultants

shall be conducted in a manner that ensures compliance with confidentiality requirements in statutes, including 35 U.S.C. 122, and regulations. **Where a written authorization is given by the applicant for the USPTO to communicate with the applicant via Internet e-mail, communications via Internet e-mail may be used.** In such cases, a paper copy of the Internet e-mail contents **MUST** be made and placed in the patent application file as required by the Federal Records Act in the same manner as an Examiner Interview Summary Form is entered. **The following is a sample authorization form which may be used by applicant:** "Recognizing that Internet communications are not secure, I hereby authorize the USPTO to communicate with me concerning any subject matter of this application by electronic mail. I understand that a copy of these communications will be made of record in the application file." A written authorization may be withdrawn by filing a signed paper clearly identifying the original authorization.

In addition and to complete the file record, applicant must now provide an authorization statement, since the email communication(s) between the Examiner and Applicant have now been made of record in the instant application.

Accordingly, the petition is **DISMISSED**.

If the petitioner desires further review of this decision, petitioner should file a Request for Reconsideration within two (2) months of the mailing date of this decision. Telephone inquiries should be directed to the undersigned at 571-272-3595.


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